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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/753,453	01/09/2004	Bernard Paul Joseph Thiers	THIE3009/JEK	8707

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EXAMINER	
CHAPMAN, JEANETTE E	

ART UNIT	PAPER NUMBER
3635	

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/753,453	THIERS ET AL.	
	Examiner	Art Unit	
	Chapman E. Jeanette	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *24-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *24-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 24-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meckstroth (3641730) in view of Haffner et al (6863768) and Hendrich (4479333).

Meckstroth discloses a set of floor panels comprising at least two types of floor panels comprising:

- A first type of floor panels of a first common length that is different from a second common length defined by a second type of floor panels; see column 2, lines 50-56
- The floor panels are defined by their lengths
- Each panel is rectangular; column 2, lines 15-20
- Each panel includes a floor panel having a layered structure 14/16/18
- Mechanical coupling 20/30 of parts defined along each of the four edges, as many connecting side edges included in the rectangular panels, of the panels.
- The coupling parts located on opposed side edges 25 of each panels 10 are arranged for locking in both vertical and horizontal directions; see figure 1
- The outer skin 14 is constructed of plywood not of decorative paper layer soaked in resin;

- The panels consist of 2,4, 6, etc..... feet sets; Thus totaling, 2 through the nth sets;
- for example the six feet set panels are all of equal length and width but the two, four and 6 feet sets each have different lengths and widths
- There are 3 different lengths thus three types of floor panels
- The first length is 6 feet, the second length is 4 feet and the third length is two feet
- Given the above, the second and the third length have a combined length generally equal to the first, the first length defines the longest length
- The combination or ratio of lengths is limitless and thus the quantity of panels to the first type may outnumber the floor panels of the other types
- The specific dimensions of the width in comparison to the length has been considered a matter of design choice; one of ordinary skill n the art would have appreciated making the pales of any dimensions commensurate with the use, purpose and function of the panels.
- The first length set of 6 feet has a first width, the second set of 4 feet has a second width, the third set has a third width

Haffner et al discloses a panel with a layered structure including decorative paper soaked in resin. See columns 5 and 6. The printed pattern decorative layer portrays a wood or parquetry pattern or a single continuous wood pattern over at least one entire surface of the respective floor panel. See column 12.One of ordinary skill in the art would have used the materials of Haffner to provide an attractive appearance while

providing resistance to chemical agents, heat, light scuff and abrasion. Hendrich (4479333) discloses building structures packaged for transportation to a building site. It is highly likely that the packaging of the panels would at least fit the largest length while not providing extra room within the package for shifting of the panels therein. One of ordinary kill in the art would have appreciated packaging the materials in any convenient, efficient and low cost manner.

Response to Arguments

Applicant's arguments filed 9/28/06 have been fully considered but they are not persuasive. Applicant argues that no every limitation is taught and the there is a lack of motivation in combining references. Applicant states, " first, Meckstroth does not disclose or suggest a set of floor panels for composing a "decorative" floor covering. Instead, it is clear from Meckstroth that it relates to "structural" panels for building components (column 2, lines 14-18)." Applicant is arguing intended use; nothing specific limiting the panel to only be used as a floor has been recited. Applicant also argues, " Obviously from robust construction of the structural panels of Meckstroth, the skilled artisan would understand that in no way would Meckstroth be adapted for use as a decorative floor covering, and would thus not consult with Meckstroth in making such a decorative floor covering.". Again, as Meckstroth and the prior art discloses the same limitations as applicant's claimed panels and used for flooring so can that of the prior art with the same limitations.

Applicant also argues that Meckstroth discloses structural panels while Haffner discloses flooring panels and the combination of the two are not reconcilable. Applicnat

further states, "this not only begs the question as to why a skilled artisan would provide a structural layer with a decorative layer but how would a skilled artisan provide the decorative layer on the structural panel of Meckstroth and upon which of the skins of the panel in Meckstroth." Applicant's attention is drawn to figure 1 of Meckstroth and figure 2 of Haffner; the two laminated construction resemble a remarkable similar appearance. One of ordinary skill in the art would have appreciated that flooring, ceiling and wall panels overlap in design and structure. With regards to placement of the layers of Haffner, one would appreciated placing the overlay and decorative layer on the top and placing the backing layers 34-38 on the bottom of Meckstroth.In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one would be motivated to combine Haffner with Meckstroth to impart an attractive patterned construction to a laminated panel while providing protection against chemical agents, heat, light ,scuffs and abrasion.

Applicant further argues, "Meckstroth....merely indicates that the panels may be fabricated in dfferent widths or lengths....but in no way teaches that these differently sized panels may be provided in a set that includes panels of different dimensions. Neither does applicant. Applicant merely recites panels of different lengths; see claim 24. Applicant is arguing more limiting than what is being claimed.

Applicnat further argues, "Lastly, it is submitted that the addition of Hendrichh with the teaching of Meckstroth and Haffner, flais to convey to one skilled in the art the feature of the pending claims wherein the set of floor panels are provided in a single package." Packaging of building supplies in a kit is not limited to flooring panels. Packaging of kits is common in the building industry as shown by Hendrich. In response to applicant's argument that Hendrich is directed to structural floor elements hingedly connected to roof elements....., the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E Jeanette whose telephone number is 703-308-1310. The examiner can normally be reached on Mon.-Fri, 8:30-6:00, every other fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAOKO SLACK can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JEANETTE CHAPMAN
PRIMARY PATENT EXAMINER
ART UNIT 3635

jec